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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,122	02/20/2007	Thomas Brinz	10191/4358	8791
26646	7590	11/30/2009	EXAMINER	
KENYON & KENYON LLP			BENITEZ, JOSHUA	
ONE BROADWAY				
NEW YORK, NY 10004			ART UNIT	PAPER NUMBER
			2829	
			MAIL DATE	DELIVERY MODE
			11/30/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/582,122	BRINZ ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JOSHUA BENITEZ	2829	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 June 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 30-58 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 30-58 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/07/2006 &amp; 02/23/2007</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____ .                        |

### **DETAILED ACTION**

1. Amended claims 30-58 of U.S. Application No. 10/582,122 filed on 06/07/2006 are presented for examination. Claims 1-29 have been cancelled.

#### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 06/07/2006 & 02/23/2007 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Drawings***

4. The drawings, more specifically figures 5 and 10, are objected to under 37 CFR 1.83(b) because they are incomplete.  
37 CFR 1.83(b) reads as follows:

When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 58 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

While the claim recites a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of In Re Bilski 88 USPQ2d 1385. The instant claims are neither positively

tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process.

The method including steps of measuring, storing, determining and calculating is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine nor is any transformation apparent. The claim language itself is sufficiently broad to read on a person determining an item on his mind and analyzing information on his mind related to the item so as to display on his mind related images in correspondence to the item to select and list candidate images. No physical structure has been claimed to perform the method.

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 30-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In re claim 30, it is unclear what Applicant means in lines 10-12 by "wherein the contacting mechanism lies against contact surfaces of the sample plate with prestressing". What does "prestressing" specifically refers to?

Claims 31-47 are also rejected for depending on claim 30.

With respect to claim 48, it is unclear from the claim as currently written and the disclosure as filed what are the fit values, what they comprise and how are they used to determine an evaluation variable.

Regarding claim 50, it is unclear what Applicant means by "a maximally measured, imaginary impedance". How is this "imaginary impedance" determined or measured if it is in fact imaginary?

Claims 49-57 are also rejected for depending on claim 48.

As for claim 58, it is unclear from the claim as currently written and the disclosure as filed what are the fit values, what they comprise and how are they used to determine an evaluation variable.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 30-34 are rejected under 35 U.S.C. 102(b) as being anticipated by **Miller et al (U.S. PGPub No. 2003/0122567)**.

In re claim 30, Miller '567 discloses in figures 1-3A a device for analysis of at least two material samples (125) disposed on a sample plate, the device including:  
a carrier (110) for the sample plate;

a contacting mechanism (130, 135, 305) for electrical contacting of the at least two material samples;

a housing carrier (140, 300 since element 300 is a modification to prior art element 140);

a measuring head (310) inserted into the housing carrier wherein the measuring head includes two measuring wires per each material sample (as shown in figure 1) for achieving electrical connection to the contacting mechanism, wherein the contacting mechanism lies against contact surfaces (126) of the sample plate with prestressing, and wherein the measuring wires are connected to a measuring and evaluation unit (150).

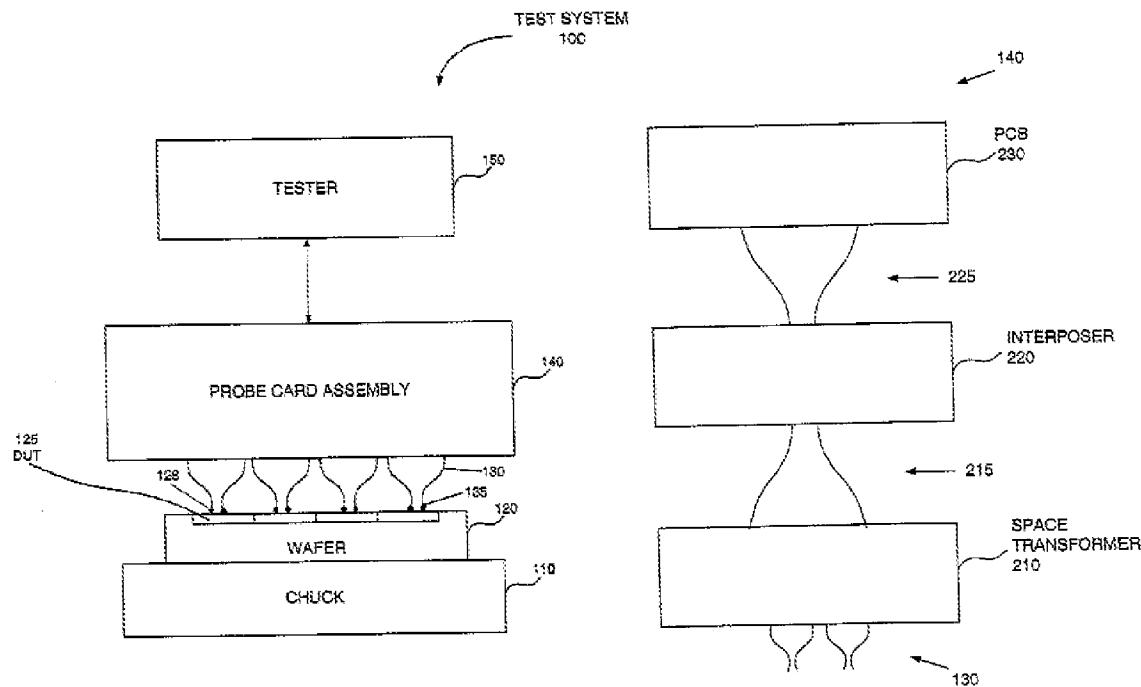


FIG. 1

FIG. 2

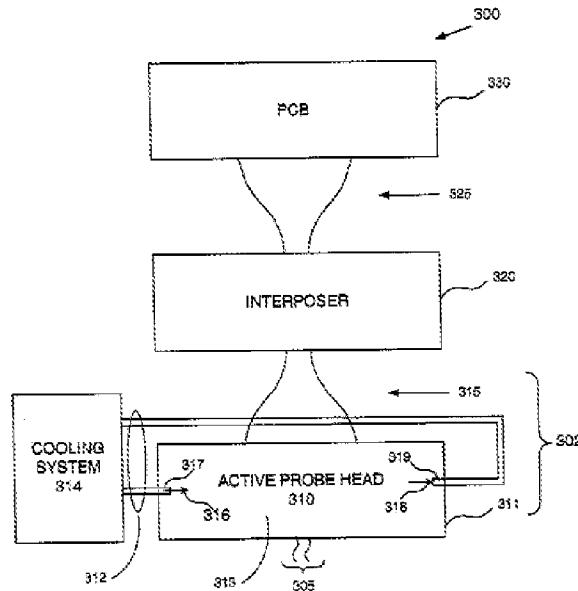


FIG. 3A

Regarding claim 31, Miller '567 discloses wherein the measuring wires are connected to fusion balls (135) which function as the contacting mechanism that lies against the contact surfaces (126) of the sample plate.

With respect to claim 32, Miller '567 discloses wherein the measuring wires are each connected to a spring contact which ensures a constant contact surface of the sample plate (par. [0062]).

As for claim 33, Miller '567 discloses wherein the measuring head (310) is connected to a gas supply unit (314).

In re claim 34, Miller '567 inherently discloses wherein the gas supply unit (314) is connected to a data processing unit of the measuring and evaluation unit since the gas supply unit must be controlled by a processing device to maintain a desired temperature during measuring.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Miller et al (U.S. PGPub No. 2003/0122567)**.

With respect to claim 35, Miller '567 discloses the claimed invention except for specifically teaching the gas supply unit including a gas mixing device.

However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have provided the gas supply unit with a gas mixing device since applicant has not disclose that the gas mixing device solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with cooling system as taught in Miller et al.

Regarding claim 36, Miller '567 discloses the claimed invention except for specifically teaching the gas supply unit including a water reservoir.

However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have provided the gas supply unit with a water reservoir since applicant has not disclose that the water reservoir solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with cooling system as taught in Miller et al.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Song et al (U.S. PGPub No. 2004/0017185)** discloses a semiconductor handler that compensates test temperature deviation due to heat produced by semiconductor device.

**Karlinsey, JR et al (U.S. PGPub No. 2005/0127931)** discloses a test cell for testing the electrochemical properties of a solid-state test specimen.

**Hembree et al (U.S. Patent No. 6,181,144)** discloses a probe card for testing semiconductor wafers, and a method for fabricating the probe card.

**Eldridge et al (U.S. Patent No. 6,468,098)** discloses an electrical interconnect assembly and methods for making an electrical interconnect assembly.

**Root et al (U.S. Patent No. 5,854,092)** discloses a method for spray cooling a tunable semiconductor device.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA BENITEZ whose telephone number is (571)270-1435. The examiner can normally be reached on M-Th, 7:30-5:00; F, 7:30-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ha Nguyen can be reached on 571-272-1678. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. B./  
Examiner, Art Unit 2829  
November 20, 2009

/Ha T. Nguyen/  
Supervisory Patent Examiner, Art Unit 2829